

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES A. TRUC

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Appeal No. 1997-2965  
Application No. 08/534,110

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ON BRIEF<sup>1</sup>

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Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 through 6, 8 through 11, 13 through 22, 25, and 27, as amended (Paper No. 7) subsequent to the final rejection (Paper No. 5). These claims constitute all of the claims remaining in the application.

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<sup>1</sup> The oral hearing scheduled for Tuesday, September 11, 2001 was waived by appellant (Paper No. 14).

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Appellant's invention pertains to a preclosed slide mount, a cardboard preclosed slide mount, and a method of forming a preclosed slide mount. A basic understanding of the invention can be derived from a reading of exemplary claims 1, 11, and 17, as they appear in the AMENDMENT AFTER FINAL (Paper No. 7).

As evidence of obviousness, the examiner has applied the documents listed below:

Staehle	2,184,007	Dec. 19,
1939		
Florjancic	3,952,434	Apr. 27,
1976		

The following rejection is before us for review.

Claims 1 through 6, 8 through 11, 13 through 22, 25, and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Staehle in view of Florjancic.

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The full text of the examiner's rejection and response to the argument presented by appellant appears in the answer (Paper No. 11), while the complete statement of appellant's argument can be found in the brief (Paper No. 10).

#### OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered appellant's specification and claims, the applied teachings,<sup>2</sup> and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

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<sup>2</sup> In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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We cannot sustain the rejection of appellant's claims.

Independent claim 1 is drawn to a preclosed slide mount comprising, inter alia, a bottom and a cover formed from a cardboard material and a plastic brace coupled between the bottom and the cover, with the bottom being bonded to the brace. Independent claim 11 sets forth a cardboard preclosed slide mount comprising, inter alia, a cardboard bottom, a cardboard cover, and a plastic brace between the cardboard bottom and the cardboard cover, with the bottom being bonded to the brace. Independent claim 17 is drawn to a method of forming a preclosed slide mount, with the method comprising, inter alia, forming a first film window into a bottom and forming a second film window into a cover, wherein the bottom and the cover are formed from cardboard material, forming a plastic brace, and bonding the bottom to the plastic brace.

As to the claimed feature of a plastic brace between a cardboard bottom and a cardboard cover, we are informed by the

underlying specification of the advantages of a plastic brace, i.e., strength and resiliency (page 3). Further, appellant explains (specification, page 6, line 27 to page 7, line 7) that being of plastic the brace is less likely to be accidentally bent, torn or otherwise damaged. It is also noted by appellant that because plastic material has shape memory, the plastic material will return the slide mount to its original shape despite accidental or temporary deformation thereof (specification, page 7, lines 9 through 19).

With the above in mind, we turn now to the examiner's evidence of obviousness.

The patent to Staehle teaches a transparent mount (Fig. 3) that includes a pair of frame members or flaps 12, 13 formed from a single sheet of paper (page 1, column 2, lines 33 through 41). Prior to folding the flaps along line 11, a hollow rectangular frame member 17 (Fig. 2) in the form of a sheet or strip of dry mounting tissue is placed on the flap 13. The dry mounting tissue has both sides thereof coated with an adhesive such that the dry mounting tissue serves to stick

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or adhere the sides of the two flaps together to hold the mount parts in assembled relation.

The Florjancic patent discloses a frame for a photographic slide that consists of a pair of rectangular masks 15, 16 (Fig. 3) made of plastic material.

The difficulty that we have with the examiner's rejection, based upon the above teachings, is that when we set aside in our minds that which appellant teaches us in the present application, we readily perceive that the applied Staehle and Florjancic documents, by themselves, simply would not have suggested the proposed modification of the transparent mount of Staehle.

Only appellant teaches a plastic brace in combination with a cardboard bottom and a cardboard cover, and the benefits derived therefrom. Thus, the rejection is clearly founded upon impermissible hindsight. Since the evidence of obviousness would not have been suggestive of the claimed invention, the rejection on appeal cannot be sustained.

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The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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